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PATENT
Docket No.: 026503-005010US

TOWNSEND and TOWNSEND and CREW LLP

By: J. M. Kelly

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John W. Patterson et al.

Application No.: 10/559,405

§ 371(c) acceptance date: June 26, 2006

For: AMIDINO COMPOUNDS AS
CYSTEINE PROTEASE INHIBITORS

Customer No.: 20350

Confirmation No.: 7243

Examiner: Celia C. Chang

Art Unit: 1625

**SECOND REQUEST FOR
RECONSIDERATION OF
PATENT TERM ADJUSTMENT
DETERMINATION UNDER 37
CFR § 1.705(d)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Pursuant to 37 C.F.R. § 1.705(d), Applicants respectfully request reconsideration of the patent term adjustment determination. This is the second request and it is not accompanied by the fee set forth in §1.18(e). Applicants respectfully request that the fee is waived, considering it was already submitted with the initial request filed on April 12, 2010. A statement of facts as required under 37 C.F.R. § 1.705(b)(2) are provided below. The Patentees believe that the Patent Term Amount reflected on the Decision mailed April 23, 2010 is not correct. A miscalculation occurred since PALM was not updated with the correct continuity data; ie: benefit under 35 USC 119(e) to U.S. Provisional Patent Application No. 60/475,612. 01/28/2011 CKHLOK 00000010 201430 10559405

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Patentees request that this request be granted based on their rights under the decision of January 7, 2010 by the United States Court of Appeals for the Federal Circuit see *Wyeth v. Kappos* Fed. Cir. 2009-1120 (attached); affirming the judgment of the district court in *Wyeth et al. v. Dudas* decision (580 F. Supp. 2d 138 (D.D.C. 2008)).

In view of the following it is respectfully requested that Applicants be granted a corrected patent term adjustment of 800 days.

Statement of Facts as required under 37 C.F.R. § 1.705(b)(2)

The correct patent term adjustment is 800 days, not 610 days as stated on the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) or 505 days as listed on the front page of U.S. Patent No. 7,662,849 B2, issued February 16, 2010.

The period of adjustment under § 1.702(a) is 610 days ("A delay").

The period of adjustment under § 1.702(b) is 438 days ("B delay").

The period of adjustment under § 1.704(a) is 105 days ("applicant delay").

The period of adjustment under § 1.703(f) is 800 days.

The Relevant Dates as Specified in 37 C.F.R. §§ 1.703(a)-(e) , §§ 1.704 and the Adjustment Specified in 37 C.F.R. § 1.703(f)

1. § 1.703(a) as applied to U.S. National Stage Applications under § 371

Applicants do not dispute that the Office did correctly calculate the term adjustments to include the adjustment that Applicants are entitled to under 37 CFR § 1.703(a) for a U.S. National Stage Application under § 371 as a total of 610 days as shown on the attached **Exhibits A** (Patent Term Adjustment History) and **C** (Applicant PTA Calculation Table). This period of time began on June 26, 2006 (date § 371(c) requirements satisfied) and ended on April 27, 2009 when a Restriction Requirement was mailed by the Office.

2. § 1.703(b) as applied to U.S. National Stage Applications under § 371

The Office failed to issue a patent within three years of the actual filing date of the above-referenced application.

The present application is the U.S. National Stage entry under 35 U.S.C. § 371 of International Application No. PCT/US04/17654, filed June 4, 2004, which claims the benefit of priority of U.S. Provisional Application No. 60/475,612, filed June 4, 2003. The Applicants noticed that the "Related U.S. Application Data" is not reflected on the Front Page of U.S. Patent No. 7,662,849 B2 (**Exhibit B**) (A Certificate of Correction is concurrently being submitted). It is, however, reflected on the attached Application Data Sheet filed during prosecution (**Exhibit D**).

Applicants submit that the "actual filing date" of a U.S. national stage application filed under 35 U.S.C. § 371, for purposes of calculating "B Delay" under 35 U.S.C. § 154(b)(1)(B), 37 C.F.R. § 1.702(b) and § 1.703(b), is the date that is 30 months from the priority date of the international application. Therefore, pursuant to the provisions of 35 U.S.C. § 371(b) and (f), the national stage for the present application "commenced" on December 4, 2005, i.e., upon expiration of 30 months from the priority date of the international application and no express request for entry was made under § 371(f).

As a result, the period beginning on December 5, 2008 (the day after the date that is three years after December 4, 2005, the date that the national stage commenced), and ending on February 16, 2010 (the date the instant U.S. Patent issued), is 438 days in length. Thus, the effective period of adjustment as applied under 37 C.F.R. § 1.702(b) is **438 days**.

371 (b) Date	3 year Date	Issue Date	Days over 3 years of issuance
December 4, 2005	December 4, 2008	February 16, 2010	438

3. § 1.703(c)-(e)

There are no relevant dates as specified under §§ 1.703(c)-(e).

4. Overlapping periods under § 1.703(a)-(e)

Applicants have calculated overlapping periods in accordance with *Wyeth v. Dudas* (88 U.S.P.Q.2d 1538, D.D.C. 2008). Periods of delay under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 1.54(b)(1)(B) overlap only if they occur on the same calendar day or days (*see Wyeth*). Applicants submit that there are **143 days** of overlap under § 1.703(a)-(e) which include the December 4, 2008 three-year date through the April 27, 2009 date of mailing of a Restriction

Requirement (*see Exhibit C*). Therefore the "A Delay" was still occurring on December 5, 2008 (start of "B Delay") and ended when a first action on the merits was mailed from the Office on April 27, 2009.

5. Reduction of Period of Adjustment of Patent Term Under 37 C.F.R. §1.704

Applicants do not dispute the calculation by the Office of the period of adjustment under § 1.704(a) as total of 105 days indicated by the attached Patent Term Adjustment History (*see Exhibits A and C*).

6. § 1.703(f)

The period of adjustment under 37 C.F.R. § 1.702(f) is as follows:

Type "A" delay:	610 days
Type "B" delay:	438 days
"A" and "B" overlap:	143 days
Applicant delay under 37 CFR 1.704 (10)	105 days
<u>Adjusted</u>	<u>800 days</u>

Terminal disclaimer

The instant application is not subject to a terminal disclaimer.

PATENT TERM ADJUSTMENT DETERMINATION

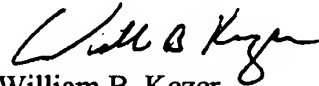
Pursuant to *Wyeth* and the provisions regarding § 371 applications, Applicants are entitled to 800 days of patent term adjustment, *i.e.*:

[1048 days (A delay + B delay) minus 143 overlap days] minus [105 days (applicant delay)].

Based on the foregoing, Applicants respectfully request reconsideration of the patent term adjustment determination.

Applicant believes that no fee is required for submission of this second Request for Reconsideration of Patent Term Adjustment Determination Under 37 CFR § 1.705(d). However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



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